

Appin No. 10/693,977
Amdt. Dated January 3, 2006
Response to Office Action of November 1, 2005

2

REMARKS/ARGUMENTS

The Office Action has been carefully considered. The issues raised are traversed and addressed below with reference to the relevant headings and paragraph numbers appearing under the Detailed Action of the Office Action.

Claim Rejections - 35 USC § 112

In paragraphs 2, 3 and 6 of the Office Action the Examiner has re-affirmed his rejection of claims 1-6 on the basis that claim 1 is a non-enabled base claim. The Applicant strongly disagrees with the Examiner's opinion.

In support of the Applicant's position, the Applicant notes that the MPEP states at §2164.08(c) "*Critical Feature Not Claimed*" that:

"...In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical. In re Goffe, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality."

In view of the above guidelines, the Applicant submits that, whilst the wording of claim 1 discloses that the inkjet printhead chip includes features of "drive circuitry" etc., the steps involved in fabricating these features specifically, is not critical to the functioning of the invention, insofar as meeting the stated objective. Instead, the steps of claim 1 are directed towards a method of fabricating an inkjet printhead chip more generally which seeks to achieve the objective stated at paragraph [0017] – that is,

"[providing a method of fabricating] a printhead chip that incorporates MEMS components that are spaced a predetermined distance from a wafer substrate so that sufficient ink ejection can be achieved."

Appln No. 10/693,977
Amdt. Dated January 3, 2006
Response to Office Action of November 1, 2005

3

Therefore, whether or not the printhead chip includes a disclosure of steps for specifically fabricating the features "drive circuitry" etc., this will not necessarily address the stated problem. The problem is however addressed by the steps which are already provided in claim 1 – that is steps for fabricating an inkjet printhead chip (generally) which overcomes the above-stated problem.

Moreover, it is evident from the specification when read as a whole, that the steps of fabricating the features of drive-circuitry etc. is non-critical to the functioning of the invention. In support of this position, the Applicant draws the Examiner's attention to the contrasting wording of the Abstract which is clearly directed only towards the steps of fabricating the inkjet printhead chip (generally) and does not refer to the steps of fabricating the above-mentioned features of the "drive circuitry" etc. The Applicant submits that the omission of the steps involved in specifically fabricating the features of "drive circuitry" etc. indicates that such steps are non-critical to the operation of the invention in achieving its object.

In view of the above comments, the Applicant respectfully submits that the Examiner has not given due weight to the specification when read as a whole, in accordance with the above-stated MPEP guidelines, and therefore the present rejection to claims 1-6 should be properly withdrawn.

As this is a final Office Action, the Applicant is not making any further comments with regard to the remaining claims or further relevance of these prior art citations as this would introduce new matters for consideration by the Examiner. The Applicant awaits the Examiner's response on this case before considering this further. In the meantime however we would respectfully submit that the if the Examiner is to maintain the objections on the grounds of these combined references, that the Examiner provide detailed evidence as to the motivation of a skilled person to combine these documents.

Appln No. 10/693,977
Amdt. Dated January 3, 2006
Response to Office Action of November 1, 2005

4

CONCLUSION

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 USC § 112. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

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